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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,968	10/09/2001	Joachim Noack	02565/93	8345

26646 7590 09/28/2006

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EXAMINER	
AHMED, AAMER S	

ART UNIT	PAPER NUMBER
3763	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/973,968	NOACK, JOACHIM	
	Examiner	Art Unit	
	Aamer S. Ahmed	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

In view of the appeal brief filed on February 2, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peabody et al (5,643,201) in view of Veech (4,668,400) and further in view of Crothall (6,049,727). Peabody et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Column 4, Line 8 - Column 6, Line 4., Entire reference).

Veech discloses measuring the concentration of an endogenous substance such as albumin.

Crothall discloses measuring an enodogenous substance in the peritoneal solution wherein the endogenous substance passes through a peritoneum (col. 13 line 56).

It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and Crothall and modify the invention of Peabody et al since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis and in order compare levels in other regions.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon et al (5,542,919) in view of Veech and further in view of Crothall. Simon et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing Peritoneal Solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate
(Column 2, Line 28 - Column 3, Line 16., Entire reference).

Veech discloses measuring the concentration of an endogenous substance such as albumin.

Crothall discloses measuring an enodogenous substance in the peritoneal solution wherein the endogenous substance passes through a peritoneum (col. 13 line 56).

It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and Crothall and modify the invention of Simon et al since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis and in order compare levels in other regions.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tysk et al (3,620,215) in view of Veech and further in view of Crothall. Tysk et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Entire reference).

Veech discloses measuring the concentration of an endogenous substance such as albumin.

Crothall discloses measuring an enodogenous substance in the peritoneal solution wherein the endogenous substance passes through a peritoneum (col. 13 line 56).

It would have been obvious to one with ordinary skill in the ad to use the teachings of Veech and Crothall and modify the invention of Tysk et al et al since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis and in order compare levels in other regions.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPA 0,149,001 in view of Veech and further in view of Crothall. EPA 0,149,001 discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Entire reference).

Veech discloses measuring the concentration of an endogenous substance such as albumin.

Crothall discloses measuring an enodogenous substance in the peritoneal solution wherein the endogenous substance passes through a peritoneum (col. 13 line 56).

It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and further in view of Crothall and modify the invention of EPA 0,149,001 since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis and in order compare levels in other regions .

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ash (US 6,409,699) in view of Veech and further in view of Crothall. Ash discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Column 6, Lines 1 - 56 Entire reference).

Veech discloses measuring the concentration of an endogenous substance such as albumin.

Crothall discloses measuring an enodogenous substance in the peritoneal solution wherein the endogenous substance passes through a peritoneum (col. 13 line 56).

It would have been obvious to one with ordinary skill in the art to use the teachings of Veech and modify the invention of Ash et al since endogenous substances are notoriously well known in the art for being used in peritoneal dialysis and in order compare levels in other regions.

Response to Arguments

Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aamer S. Ahmed whose telephone number is 571-272-5965. The examiner can normally be reached on Monday thru Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A. Ahmed

Acting SPE
AU 3763